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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/538,318

06/13/2005

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EXAMINER

MORRIS, PATRICIA L

ART UNIT

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1625

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/538,318	Applicant(s) BERGGREN ET AL.	
	Examiner Patricia L. Morris	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) 7-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/13/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-3 and 5 are under consideration in this application.

Claims 7-11 are held withdrawn from consideration as being drawn to nonelected subject matter 37 CFR 1.142(b).

Election/Restrictions

Applicant's election of Group I and example 2 in the reply filed on December 14, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The restriction requirement is deemed sound and proper and is hereby maintained.

This application has been examined to the extent readable on the elected compounds wherein R¹, R² represent (optionally substituted) phenyl, R³ represents -XYNR⁴R⁵, R⁴ and R⁵ together with the nitrogen atom form a piperidine or one of R⁴ or R⁵ represents a piperidine or - (CH₂)_tpiperidine and X, Y and t as set forth in claim 1, exclusively. All additional heterocycles pertain to nonelected subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is a lack of description as to how the solvates or prodrugs are produced and what solvates or prodrugs are produced in the specification. Vippagunta et al. states on page 18 states that predicting the formation of solvates of a compound and the number of molecules of solvent or water incorporated into the crystal lattice of a compound is complex and difficult. Prodrugs and metabolites are very difficult to find. Note pages 976-977 of Manfred et al.

Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The expressions solvate and prodrug are employed in claims 1-3 with no indication given as to what the groups really are.

One should be able, from a reading of the claims, determine what that claim does or does not encompass.

Why? Because that claim precludes others from making, using, or selling that compound for 20 years. Therefore, one must know what compound is being claimed.

The specification lacks direction or guidance for placing all of the alleged products in the possession of the public without inviting more than routine experimentation. Applicants are referred to In re Fouche, 169 USPQ 429 CCPA 1971, MPEP 716.02(b).

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement

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and whether any necessary experimentation is undue. These factors include 1) the breadth of the claims, 2) the nature of the invention, 3) the state of the prior art, 4) the level of one of ordinary skill, 5) the level of predictability in the art, 6) the amount of direction provided by the inventor, 7) the existence of working examples, and 8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

The nature of the invention

The nature of the invention is the preparation of compounds.

State of the Prior Art

Prodrugs and solvates can have very different properties. . Prodrugs and solvates tend to convert from less stable to more stable forms. No method exists to predict what prodrug or solvate will work with any significant certainty. Prodrugs and solvates can convert from one form to another during the manufacturing process of a pharmaceutical drug and will change the pharmacological affects of the drug. This is why it is important to monitor the compounds during manufacture of the drug to see if it persists during manufacture.

Further, predicting the formation of solvates of a compound and the number of molecules of solvent incorporated into the crystal lattice of a compound is complex and difficult. Each solid compound responds uniquely to the possible formation of solvated and hence generalizations cannot be made for a series of compounds. Note section 3.4 of Vippaguant et al.

The amount of direction or guidance and the presence or absence of working examples

The specification fails to describe any prodrugs or solvates. Prodrugs and solvates often change into other forms during drug manufacture. Guillory on page 199 recites that compounds

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originally crystallized as solvates can lose the solvent induced by heat or vacuum vaporization.

Based on the unpredictability in the art, applicants are not entitled to any and all unknown prodrugs or solvates.

The written description is considered inadequate here in the specification. Conception of the intended group should not be the role of the reader. Applicants should, in return for a 20 year monopoly, be disclosing to the public that which they know as an actual demonstrated fact. The disclosure should not be merely an invitation to experiment. This is a 35 USC 112, first paragraph. If you (the public) find that it works, I claim it, is not a proper basis of patentability. In re Kirk, 153 USPQ 48, at page 53.

The breadth of the claims

The breadth of the claims are drawn to all potential prodrugs and solvates in addition to the instant compounds.

The quantity of experimentation needed

The quantity of experimentation needed would be undue when faced with the lack of direction and guidance present in the instant specification in regards to the compounds and their unknown other forms being claimed.

Wolff, Manfred E. "Burger's Medicinal Chemistry", pages 975-977, summarizes the state of the prodrug art. The table on the left side of page 976 outlines the research program to be undertaken to find a prodrug. The second paragraph in section 10 and the paragraph spanning pages 976-977 indicate the low expectation of success. Vippanunta et al. recites the state of the solvate art.

In terms of the 8 Wands factors, undue experimentation would be required to make or use the invention based on the content of the disclosure due to the breadth of the claims, the level of unpredictability in the art of the invention, and the poor amount of direction provided by applicants. Taking the above factors into consideration, it is not seen where the instant other forms are enabled by the instant application.

Genentech Inc v. Novo Nordisk A/S (CAFC) 42 USPQ2d 1001, states that “a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion” and [p]atent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable”.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expressions prodrug and solvate in claims 1-3 are indefinite.

The claims measure the invention. United Carbon Co. v. Binney & Smith., 55 USPQ 381 at 384, col. 1, end of 1st paragraph, Supreme Court of the United States (1942).

The U.S. Court of Claims held to this standard in Lockheed Aircraft Corp. v. United States, 193 USPQ 449, “Claims measure invention and resolution of invention must be based on what is claimed”.

The C.C.P.A. in 1978 held “that invention is the subject matter defined by the claims submitted by the applicant. We have consistently held that no applicant should have limitations

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of the specification read into a claim where no express statement of the limitation is included in the claim”: In re Priest, 199 USPQ 11, at 15.

Allowable Subject Matter

Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if rewritten directed solely to the subject matter indicated as being examinable, supra. A claim so limited would appear allowable.

Claim 1 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and if rewritten directed solely to the elected compounds.

Claims 2 and 3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims and if rewritten directed solely to the elected compounds.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688. The examiner can normally be reached on Mondays through Fridays.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patricia L. Morris/

Primary Examiner, Art Unit 1625

Patricia L. Morris
Primary Examiner
Art Unit 1625

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February 21, 2008